

Group II (claims 19-25, 39-40) drawn to “the apparatus of a flywheel system with a controller”. Separate utility: used to control the alternator output.

Group III (claims 26-29, 33-36 and 41) drawn to the apparatus of a flywheel device”. Separate utility: used to generate electricity.

Group IV (claims 30-32, 37 and 38) drawn to the apparatus of a flywheel system with magnetic bearings”. Separate utility: used to support a rotor rotation without contacting.

Applicant believes that these “separate utilities” are not separate utilities at all, they are merely various functions that are performed by the inventive flywheel system. All four groups of claims identified by the Examiner claim a flywheel system. They all have the same utility: storing energy in the form of rotational inertia of a flywheel, and delivering it back again when needed in the form of electric power. The invention is claimed differently in the several claims, but Applicant is not aware of any requirement that every claim have all the elements of every other claim to avoid a restriction requirement based on “separate utility.”

The only difference in the Examiner’s characterization of groups I and IV is that one has mechanical bearing and the other has magnetic bearings. That does not constitute separate utility. They are both flywheel systems. They may be separate species, and a requirement for election of species may be appropriate if the Examiner believes that flywheel systems with mechanical bearings and similar flywheel systems with mechanical bearings are patentable over each other. But to say that the different types of bearings in similar flywheel systems give them “separate utility” is elevate the term “separate utility” to the point of meaninglessness. If these claim groups can be considered to have “separate utility”, then it would be hard to imagine any two independent claims that are not identical that would not also have “separate utility.”

Claim 1 is not restricted to mechanical bearings as the Examiner suggests. It claims bearings generically. Mechanical bearings are not claimed specifically in Group I until claims 11 and 12, and claims 11 and 12 also claim a magnetic suspension for the majority of the weight of the rotor. Thus, for at least claims 1-10 and 13-18, there is no basis for the distinction asserted by the Examiner, and for claims 11 and 12, there is still no basis for any distinction.

The "separate utility" of Group III is that it can be used to generate electricity. All 41 claims in this application cover an invention for generating electricity. There is nothing "separate" to Group III about that particular utility.

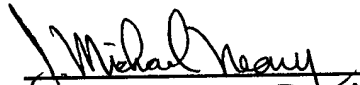
The "separate utility" of Group II is not unique to Group II. Claims 31 and 32 from Group IV also claim power control.

Accordingly, Applicant believes that there is no basis for asserting that the claims in this Application define four separate inventions. Applicant believes that there is in fact only a single invention, which is claimed in various ways, as is permitted. Applicant does not believe that every claim must contain all the elements of every other claim to avoid the assertion that the invention defined in the several claims all have "separate utility."

Applicant respectfully solicits an examination of all the claims in this Application.

Respectfully submitted,

542 SW 298th Street
Federal Way, Washington 98023
voice: (253) 941-7683; fax: (253) 941-3623


J. Michael Neary, Reg. No. 25,453
Attorney for Applicant